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Dated: October 5, 2009

Electronic Signature for Elizabeth A. Hanley: /Elizabeth A. Hanley/

Docket No.: 117750-04703
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Prasad Koteswara KAPA *et al.*

Application No.: 10/527,628

Confirmation No.: 9537

Filed: May 25, 2005

Art Unit: 1626

For: PROCESS FOR PREPARING
INTERMEDIATES

Examiner: Rodriguez-Garcia, Valerie

MS Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT UNDER 37 C.F.R. § 1.705(b)(2)

Dear Sirs:

1. This statement is respectfully submitted in support of the “Request for Reconsideration of the Patent Term Adjustment Under 37 C.F.R. § 1.705(d)” being filed herewith for the above-referenced patent application. In view of the following, it is respectfully requested that Applicants be granted a Patent Term Adjustment of 1,146 days.

2. Pursuant to 37 C.F.R. § 1.705(b)(2)(i), Applicants respectfully submit that the correct period of Patent Term Adjustment is 1,146 days which includes A-delays, B-delays and overlap between A-delays and B-delays. First, pursuant to 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1), Applicants are entitled to an adjustment of 787 days due to the U.S. Patent and Trademark Office’s (USPTO) failure to mail a notification or notice of allowance prior to 14 months after the date on which the Applicant fulfilled the requirements of 35 U.S.C. § 371 (A-delays). Pursuant to 37 C.F.R. §§ 1.702(b)(1) and 1.703(b), Applicants are also entitled to an adjustment of 550 days due to the USPTO’s failure to issue a patent within 3 years of the commencement of

this application under 35 U.S.C. § 371(b) (B-delays). Pursuant to 35 U.S.C. § 154(b)(2)(A), the Patent Term Adjustment is reduced by 189 days due to overlap of A-delays and B-delays. Accordingly, pursuant to 37 C.F.R. § 1.703(f), Applicants are entitled to a Patent Term Adjustment of 1,146 days, which is equivalent to the sum of the A-delays and B-delays minus the overlap terms.

3. The relevant dates, pursuant to 37 C.F.R. § 1.705(b)(2)(iii), and the adjustment that the patent will be entitled to, pursuant to 37 C.F.R. § 1.703(f), are set forth as follows:

A-Delays: USPTO Examination Delays Pursuant to 37 C.F.R. § 1.702(a) and § 1.703(a)

In the instant application, Applicants note that the Issued patent allotted 787 days of Patent Term Adjustment due solely to USPTO A-delays. Applicants do not dispute the USPTO's calculation of A-delays.

Accordingly, the USPTO has accrued a summed total of 787 days of A-delay.

B-Delays: USPTO Three-Years Delay Pursuant to 37 C.F.R. § 1.702(b) and § 1.703(b)

In the instant case, the Patent Term Adjustment listed on the issued patent granted 0 days of B-delays. However, Applicants believe that this Patent Term Adjustment has been made in error. Applicants respectfully note that the national stage of the application commenced on March 14, 2005. The three-year period, for purposes of calculating B-delays, ended on March 14, 2008. Accordingly, pursuant to 37 C.F.R. § 1.703(b), Applicants are entitled to a Patent Term Adjustment that is equivalent to the sum of the number of days in the period beginning on March 14, 2008 and ending on the date that the patent issues. Applicants note that the patent issued on September 15, 2009. The sum of the period beginning on March 14, 2008 and ending on September 15, 2009 is 550 days.

Accordingly, the USPTO has accrued 550 days of B-delay.

Reduction of Patent Term Adjustment Pursuant to 37 C.F.R. § 1.704(a)

Applicants note that the notice of allowance attributed 0 days of reduction to the Applicants. Applicants do not dispute this reduction.

Exclusions From Patent Term Adjustment Pursuant to 37 C.F.R. § 1.703(b)(4)

Applicants note that the notice of allowance attributed 0 days of exclusions to the Applicants. Applicants do not dispute this exclusion.

Overlapping Periods of USPTO A-Delays and B-Delays Pursuant to 37 C.F.R. § 1.703(f)

As set forth in 37 C.F.R. § 1.703(f), the period of adjustment based on the grounds set forth in 37 C.F.R. § 1.702 is the sum of all periods of Examination Delay and the maximum period of Three Years Delay, to the extent these periods of delay are not overlapping. Pursuant to 37 C.F.R. 1.703(f), the period of adjustment will not exceed the actual number of days the issuance of the patent was delayed. Applicants note that the U.S. District Court of D.C. has recently clarified that under 35 USC § 154(b)(2)(A) the only way a period of Examination Delay (“A-delay”) and a period of Three-Years Delay (“B-delay”) can “overlap” is if they occur on the same calendar day or days. *See Wyeth v. Dudas*, No. 07- 1492. 2008 U.S. Dist. LEXIS 76063 at 9 (D. D.C. Sept. 30, 2008). In the instant case, the B-delays began on March 14, 2008 and the A-delays ended on September 19, 2008. The overlap is therefore the period beginning on March 14, 2008 and ending on September 19, 2008. Accordingly, there were 189 days of overlap between A-delays and B-delays.

4. In accordance with 37 C.F.R. 1.705(b)(2)(iii), Applicants submit that the above-referenced application is not subject to a terminal disclaimer.

5. In view of 37 C.F.R. 1.705(b)(2)(iv)(A), Applicants submit that they are unaware of any circumstances during the prosecution of the application that would constitute a failure to engage

in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

6. In view of the foregoing, it is respectfully requested that this Request for Reconsideration of the Patent Term Adjustment be favorably considered and that the issued patent be edited reflect a Patent Term Adjustment of 1,146 days.

7. In accordance with 37 C.F.R. 1.705(b)(2)(i), Applicants submit herewith the fee set forth in 37 C.F.R. 1.18(e). It is Applicants' understanding that this \$200.00 fee is required for this application for Patent Term Adjustment. However, should any additional fees be necessary, the Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-4876, under Order No. 117750-04703.

Dated: October 5, 2009

Respectfully submitted,

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